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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/092,722	03/08/2002	Masahide Ogawa	P 290786 RIG500236-USA-A	7348

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EXAMINER	
BEKERMAN, MICHAEL	
ART UNIT	**PAPER NUMBER**
3622	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/19/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/092,722	OGAWA, MASAHIDE	
	Examiner	Art Unit	
	Michael Bekerman	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *23 February 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *4-13* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *4-13* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *2/23/2007*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102(b)

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

   A person shall be entitled to a patent unless –

   (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. **Claims 4-6, 8, 9, 11 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Ikeda, et. al. U.S. Patent number 5,937,391.**

3. **As in claim 4**, Ikeda, et. al. teaches a virtual mall apparatus comprising: means for virtually constructing a virtual mall including a plurality of virtual shops (fig. 2, item 12; fig. 3); means for generating a purchased item data when a purchase command is input (col. 2, line 64), the purchase command indicating that a purchaser buys an item at one of the plurality of shops, the purchased item data including a store code identifying one of the virtual shops at which the item is purchased, an item code identifying the item purchased and a discount item flag indicating that the purchased item is a discount item, the discount item flag being set where the purchased item is specified as a discount item by one of the plurality of shops; means for discriminating whether items indicated by at least two discount item flags in a plurality of purchased item data are respectively purchased from different shops based on the purchased item data (fig 8); and means for executing a discount if the

discriminating means determines that the items indicated by the at least two discount item flags are purchased from different shops (col. 14, lines 36-39).

4. **As in claim 5**, Ikeda, et. al. teaches an apparatus according to claim 4, wherein the discount is applied to items of different shops indicated by the at least two discount item flags, further including means for collecting each discount applied to the items classified by shop (fig 16). In this system, the redemption of the points means to redeem the points for discount, refund or an awarding gift (col. 1, lines 32-33).
5. **As in claim 6**, Ikeda, et. al. teaches an apparatus according to claim 4 further including means for selecting one item from at least two different items indicated by at least two discount item flags if the at least two different items indicated by the at least two discount item flags are purchased at the same shop (figs. 11 & 12).
6. **As per claim 8**, Ikeda, et. al. teaches a method for performing a discount service in a virtual mall which comprises a plurality of virtual shops, including steps of: generating a purchased item data (fig 13) when a purchase command is input, the purchase command indicating that a purchaser buys an item at one of the plurality of shops, the purchased item data including a store code (fig 13, shop "space development" code "5002") identifying one of the virtual shops at which the item is purchased, an item code (fig 13, "goods number) identifying the item purchased and a discount-item flag indicating that the purchased item is a discount item (fig 13, "points deposited"), the discount item flag being set where the purchased item is specified as a discount item by one of the plurality of shops; discriminating whether items indicated by at least two discount item flags in a plurality of purchased item

data are respectively purchased from different shops based on the purchased item data (fig 8); and executing a discount (col. 16, lines 33-37) if the discriminating means determines that the items indicated by the at least two discount item flags are purchased from different shops.

7. **As per claim 9**, Ikeda, et. al. teaches a method according to claim 8 further including step of selecting one item from at least two different items indicated by at least two discount item flags if the at least two different items indicated by the at least two discount item flags are purchased at the same shop (fig 11).
8. **As per claim 11**, Ikeda, et. al. teaches computer executable codes, stored in a computer readable medium, which when executed codes: virtually creating a virtual mall including a plurality of virtual shops (col. 16, lines 1316); generating a purchased item data when a purchase command is input (col. 16, lines 17-18), the purchase command indicating that a purchaser buys an item at one of the plurality of shops, the purchased item data including a store code identifying one of the virtual shops at which the item is purchased, an item code identifying the item purchased (col. 16, lines 26-29) and a discount item flag indicating that the purchased item is a discount item, the discount item flag being set where the purchased item is specified as a discount item by one of the plurality of shops (col. 16. lines 33-36); discriminating whether items indicated by at least two discount item flags in a plurality of purchased item data are respectively purchased from different shops based on the purchased item data (col. 14, lines 7-10); and executing a discount if

the items indicated by the at least two discount item flags are purchased from different shops (figure 8).

9. **As in claim 12**, Ikeda, et. al. teaches computer executable codes according to claim 11 further selecting one item from at least two different items (figure 13, col. 9, lines 50) indicated by at least two discount item flags if the at least two different items indicated by the at least two discount item are purchased at the same shop.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

11. **Claims 7, 10 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ikeda, et. al. U.S. patent number 5,937,391 in view of Philippe, et. al. U.S. patent number 6,643,624.**

12. **Referring to claim 7**, Ikeda, et. al. teaches an apparatus according to claim 6, with all the limitations thereof.

13. Ikeda, et. al. does not expressly teach an apparatus wherein the selecting means includes a means for comparing a selling price of one of the at least two different

items with a selling price of the other item to select one item having a higher selling price if selling prices of the at least two different items are different one another.

14. Philippe, et. al. teaches an apparatus according to claim 6, wherein each item of the at least two different items has a selling price and the selecting means includes *means for* comparing a selling price of one of the at least two different items with a selling price of the other item to select one item having a higher selling price if selling prices of the at least two different items are different one another (fig 2C).

15. A person having ordinary skill in the art would have been aware of these two disclosures and would have been motivated to combine them in order to alleviate the problems outlined in Ikeda, et. al. of stores having to prepare a number of coupons and pay for the coupons [in the actual printing and handling] (Ikeda, et. al. col. 1, line 51-52).

16. **Referring to claim 10**, Ikeda, et. al. teaches the method of claim 9, with all the limitations thereof.

17. Ikeda, et. al. does not expressly teach a method according to claim 9, wherein each item of the at least two different items has a selling price and the selecting step includes step of comparing a selling price of one of the at least two different items with a selling price of the other item to select one item having a higher selling price if prices of the at least two different items are different to one another.

18. Philippe, et. al. teaches a method for performing a service in a virtual mall which comprises a plurality of virtual shops, including steps of: generating a purchased item data when a purchase command is input, the purchase command indicating

that a purchaser buys an item at one of the plurality of shops, the purchased item data including a store code identifying one of the virtual shops at which the item is purchased, an item code identifying the item purchased and a discount-item flag indicating that the purchased item is a discount item, the discount item flag being set where the purchased item is specified as a discount item by one of the plurality of shops (col. 9, lines 53-56); discriminating whether items indicated by at least two discount item flags in a plurality of purchased item data are respectively purchased from different shops based on the purchased item data (col. 9, lines 58-61); and executing a discount if the discriminating means determines that the items indicated by the at least two discount item flags are purchased from different shops (col. 10, lines 15-16). Executing a discount in this instance is a subset of executing a transaction; discount terms being part of the product question transactions (col. 7, lines 34-35). Philippe, et. al. also teaches a method further including the step of selecting one item from at least two different items (fig 2c), and a method wherein each item of the at least two different items has a selling price and the selecting step includes the step of comparing a selling price of one of the at least two different items with a selling price of the other item (fig 2c). Philippe, et. al. does not explicitly teach a discounting service.

19. A person having ordinary skill in the art would have been aware of these two disclosures and would have been motivated to combine them in order to alleviate the problems outlined in Ikeda, et. al. of stores in the redemption process (Ikeda, et. al. col. 1, line 51-55).

20. **Referring to claim 13**, Ikeda, et. al. teaches the system of claim 11 with all the limitations thereof.

21. Ikeda, et. al. does not expressly teach, each item of the at least two different items has a selling price, comparing a selling price of one of the at least two different items with a selling price of the other item to select one item having a higher selling price if prices of the at least two different items are different one another.

22. Philippe, et. al. teaches the system of claim 11, a computer executable codes, stored in a computer readable medium, which when executed codes: virtually creating a virtual mall including a plurality of virtual shops (col. 12, lines 51, 52); generating a purchased item data when a purchase command is input, the purchase command indicating that a purchaser buys an item at one of the plurality of shops, the purchased item data including a store code identifying one of the virtual shops at which the item is purchased, an item code identifying the item purchased (col. 12, lines 53-55) and a discount item flag indicating that the purchased item is a discount item, the discount item flag being set where the purchased item is specified as a discount item by one of the plurality of shops (col. 13, line 3); discriminating whether items indicated by at least two discount item flags in a plurality of purchased item data are respectively purchased from different shops based on the purchased item data (col. 12, lines 53-54); and executing a discount if the items indicated by the at least two discount item flags are purchased from different shops (col. 13, line 3).

23. Philippe, et. al. teaches the additional limitation of claim 13 of computer executable codes according to claim 11, wherein each item of the at least two different items

has a selling price, comparing a selling price of one of the at least two different items with a selling price of the other item to select one item having a higher selling price if prices of the at least two different items are different one another (col. 14, lines 4-6).

24. A person having ordinary skill in the art would have been aware of these two disclosures and would have been motivated to combine them in order to facilitate customer lock-in and sales promotion as noted in Ikeda, et. al. (col. 1, lines 12-13) and which Ikeda, et. al. notes was one of the most popular types of systems at the time of the invention (Ikeda, et. al. col. 1, line 12).

Response to Arguments

Applicant argues the 102(b) rejections are not appropriate because the Ikeda reference does not contain every limitation recited in the claims. Examiner sets forth that due to Applicant's broad claim language the Ikeda reference does indeed anticipate applicant's pending claims. In figure 8 of Ikeda, the "Points" column represents discount item flags and the "purchase data" column represents items that were purchased. The points merely being present in the system for each purchased item represents a "flag", and since those points indicate a discount, Examiner considers these to represent discount item flags. The "Name of Shop" column shows that items are discriminated to show they were purchased at more than one retailer (Evidenced by shop name A through D signifying at least 4 different shops). Ikeda additionally has means for executing a discount as displayed by Column 14, Lines 36-39. Applicant's claim language states that a discount is executed if items are purchased from different shops.

Applicant's claims do not specify that the discount does not occur when the items do not meet that limitation. The system of Ikeda provides this discount in all situations, not just the one specified by applicant. Therefore, Ikeda provides the discount when items are purchased at different stores (as recited by the claims) and when the items are purchased at the same store.

As those skilled in the art can clearly see, Ikeda is a proper teaching for the claims as they currently stand. In view of Applicant's arguments, Examiner has dropped the 102(e) rejections based on the Philippe reference, however the rejections over Ikeda appear to be proper.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Bekerman whose telephone number is (571) 272-3256. The examiner can normally be reached on Monday - Friday, 7:30 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric W. Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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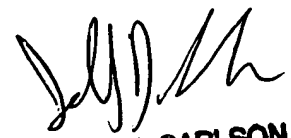

JEFFREY D. CARLSON
PRIMARY EXAMINER